

## **REMARKS**

Applicants respectfully request reconsideration and reexamination of the present application in light of the foregoing amendments and following remarks.

Amendments are made without disclaimer of any subject matter, and Applicants expressly reserve the right to claim such subject matter in a subsequently filed continuing application. Amendments to the claims are supported throughout the application as filed. A pharmaceutical composition comprising a therapeutically effective amount of at least one of the flavone C-glycoside derivative or salt thereof according to claim 1 or claim 2 to treat an allergic disease is described at page 10, lines 1-9 (“The unit dose is generally in the range of 0.0001 to 100 mg/kg, which is administered one to three times in 24 hours.”); page 18, lines 11-13; and page 19, lines 24-26, for example. A food or cosmetic comprising a therapeutically effective amount of at least one of the flavone C-glycoside derivative or salt thereof to treat an allergic disease is described at page 13, lines 24-27, for example. Exemplary support for new claims 15 and 16 is found throughout the specification, e.g., page 7, line 17, *et seq.* (uses of the disclosed compositions for various applications), page 8, line 14, *et seq.* (administration of the compositions), page 10, line 6 (administration to a “patient”), and the examples.

### **1. Status of the Claims**

Claims 1-14 are pending. Claims 1 and 2 are allowable. Claims 3-14 stand rejected. Claims 15 and 16 are added by entry of the present amendment.

### **2. Status of the Drawings**

The drawings submitted January 3, 2005, are deemed acceptable by the Examiner.

### **3. Acknowledgement of Certified Priority Documents**

Applicants note with appreciation the acknowledgement of receipt of the Certified Priority Document.

**4. Acknowledgement of Information Disclosure Statements**

Applicants appreciate consideration of the Information Disclosure Statement (IDS) filed January 30, 2007. Applicants note for the record that the IDS filed January 30, 2007, incorrectly lists the publication date of WO 2004/092180 as October 24, 2004. The correct date is October 28, 2004. *See* WO 2004/092180, front page. As a courtesy, Applicants provide (1) a corrected form PTO-1449. No fees are believed required to provide this courtesy copy. Applicants respectfully request that the Office causes the front page of the issued patent to list the publication date of WO 2004/092180 as October 28, 2004.

Applicants further note that the Examiner did not consider the references submitted with the IDS filed January 3, 2005, because the Examiner did not receive copies of the cited references from the International Search Authority. As a courtesy, Applicants presently file (2) copies of the cited references, (3) a clean copy of the form PTO-1449, filed January 3, 2005, and (4) a revised IDS reflecting submission under 37 C.F.R. § 1.97(c). Applicants additionally provide English language summaries of JP 10-77231 and JP 3-157330, listed on the PTO-1449, attached to copies of these references.

Applicants do not believe that further fees are due, because the International Search Authority is responsible for forwarding copies of the cited references to the designated Office. To ensure timely consideration of the IDS, however, Applicants submit the IDS under 37 C.F.R. § 1.97(c) and provide the \$180.00 set forth in 37 C.F.R. § 1.17(p). The Office is hereby authorized to charge additional fees to Deposit Account No. 50-0573 or to reimburse Applicant by depositing the fees to the same deposit account.

**5. Claim Objections**

Claim 4 is objected under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Office specifically alleges that Claim 4 does not further limit Claim 3, because the Office does not consider the intended use of the composition of Claim 3 to limit the claim. The objection is mooted by the amendment to Claim 3. Claim 4 now further limits the “allergic diseases” recited in Claim 3 as at least one selected from atopic dermatitis, contact dermatitis and pollenosis.

**6. Rejections Under 35 U.S.C. § 112, Second Paragraph**

(1) Claims 3-4, 10-11, and 14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office alleges that it would be unclear to the skilled artisan how both to treat and prevent a disease. The rejection is mooted in view of the present amendments to Claims 3 and 11.

(2) Claims 10 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office alleges that the claimed methods are unclear because they do not comprise a method step. The rejection is mooted by the amendments to Claims 10 and 14, which add a method step to the claims.

**7. Rejection Under 35 U.S.C. § 102(b)**

Claims 3-7, 10-12, and 14 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,409,692 ("Nakahara"). Applicants traverse the rejection.

Nakahara allegedly discloses compositions, namely foods and beverages, containing an oolong tea extract. Office Action, page 3. It is well established that "inherency . . . may not be established by probabilities or possibilities." *In re Oelrich*, 666 F.2d 578, 581-82 (C.C.P.A. 1981). In the present case, Applicants assume *arguendo* (i.e., for the sake of argument only) that the food or beverage disclosed in Nakahara contains some amount of the flavone C-glycoside derivative or salt thereof according to formula 1 or formula 2. Even if this were the case, however, the Office has not provided evidence that the food or beverage disclosed in Nakahara necessarily comprises a therapeutically effective amount of at least one of the flavone C-glycoside derivative or salt thereof according to claim 1 or claim 2.

Accordingly, the evidence only indicates at best the *mere possibility* that the food or beverage disclosed in Nakamura has the inherent property of comprising a therapeutically effective amount of a flavone C-glycoside derivative or salt thereof according to claims 1 or 2.

Because the rejection is improperly based on inherency established only by possibilities, no proper *prima facie* case of anticipation has been adduced. Accordingly, the rejection should be withdrawn.

**8. Rejection Under 35 U.S.C. § 102(e)(1)**

Claims 3-14 stand rejected under 35 U.S.C. § 102(e)(1) as being allegedly anticipated by U.S. Published Application No. 2002/0136753 A1 ("Uehara"). Applicants traverse the rejection.

Uehara allegedly discloses an anti-allergenic composition comprising an oolong tea extract. Office Action, page 4. It is well established that "inherency . . . may not be established by probabilities or possibilities." *In re Oelrich*, 666 F.2d 578, 581-82 (C.C.P.A. 1981). In the present case, Applicants assume *arguendo* that the composition disclosed in Uehara contains some amount of the flavone C-glycoside derivative or salt thereof according to formula 1 or formula 2. Even if this were the case, however, the Office provides no evidence that the composition disclosed in Uehara necessarily comprises at least one of the flavone C-glycoside derivative or salt thereof according to claim 1, or claim 2 as an anti-allergic component in a therapeutically effective amount to treat an allergic disease, as presently claimed. Accordingly, the evidence only indicates at best the *mere possibility* that the composition disclosed in Uehara has the inherent property of comprising a therapeutically effective amount of a flavone C-glycoside derivative or salt thereof according to claims 1 or 2. Because the rejection is improperly based on inherency established only by possibilities, no proper *prima facie* case of anticipation has been adduced. Accordingly, the rejection should be withdrawn.

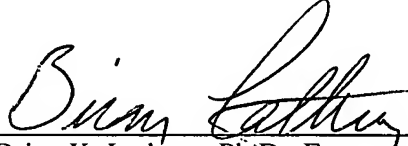
### CONCLUSION

In view of the above arguments and amendments to the claims, Applicants respectfully assert that the claims are condition for allowance and respectfully request a Notice of Allowance.

Should any issues remain outstanding or if there are any questions concerning this paper, or the application in general, the Examiner is invited to telephone the undersigned representative at the Examiner's earliest convenience. Should any outstanding fees be owed or overpayments credited, the Commissioner is invited to charge or credit Deposit Account No. 50-0573 accordingly.

Respectfully submitted,

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